	Application No.	Applicant(s)
	09/767,110	HICKS, SCOTT G.
Notice of Allowability	Examiner	Art Unit
	J. Bret Dennison	2143
The MAILING DATE of this communication ap All claims being allowable, PROSECUTION ON THE MERITS herewith (or previously mailed), a Notice of Allowance (PTOL-I NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT of the Office or upon petition by the applicant. See 37 CFR 1.3	ppears on the cover sheet winds (OR REMAINS) CLOSED in 85) or other appropriate communication is second to the second control of RIGHTS.	th the correspondence address n this application. If not included unication will be mailed in due course. THIS
1. This communication is responsive to <u>09/03/2004</u> .		
2. 🔀 The allowed claim(s) is/are <u>1-3,5,7-12,14,15,17,19-25 a</u>	<u>nnd 27</u> .	
3. $igotimes$ The drawings filed on 21 January 2001 are accepted by	the Examiner.	
<ul> <li>4. Acknowledgment is made of a claim for foreign priority a) All b) Some* c) None of the:</li> <li>1. Certified copies of the priority documents head Copies of the priority documents head Copies of the certified copies of the priority International Bureau (PCT Rule 17.2(a)).</li> <li>* Certified copies not received:</li> </ul>	ave been received. ave been received in Applicatio	on No
Applicant has THREE MONTHS FROM THE "MAILING DAT noted below. Failure to timely comply will result in ABANDO THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.		a reply complying with the requirements
5. A SUBSTITUTE OATH OR DECLARATION must be su INFORMAL PATENT APPLICATION (PTO-152) which (	bmitted. Note the attached EXA gives reason(s) why the oath or	AMINER'S AMENDMENT or NOTICE OF reclaration is deficient.
6. CORRECTED DRAWINGS (as "replacement sheets") r  (a) including changes required by the Notice of Draftsp  1) hereto or 2) to Paper No./Mail Date  (b) including changes required by the attached Examin Paper No./Mail Date  Identifying indicia such as the application number (see 37 CF each sheet. Replacement sheet(s) should be labeled as such  7. DEPOSIT OF and/or INFORMATION about the de	person's Patent Drawing Review ner's Amendment / Comment or R 1.84(c)) should be written on the time the header according to 37 CF	in the Office action of the drawings in the front (not the back) of R 1.121(d).
attached Examiner's comment regarding REQUIREMEN		
Attachment(s)  1. ☑ Notice of References Cited (PTO-892)  2. ☑ Notice of Draftperson's Patent Drawing Review (PTO-94)  3. ☑ Information Disclosure Statements (PTO-1449 or PTO/S Paper No./Mail Date	8) 6. 🛭 Interview So Paper No./	formal Patent Application (PTO-152) ummary (PTO-413), Mail Date <u>12/08/2004</u> . Amendment/Comment
Examiner's Comment Regarding Requirement for Depos of Biological Material	sit 8. ⊠ Examiner's 9. □ Other	Statement of Reasons for Allowance  Primary Examine  Art Unit 21489  William C. Varahn. Tr

U.S. Patent and Trademark Office PTOL-37 (Rev. 1-04)

Art Unit: 2143

#### **DETAILED ACTION**

This Action is in response to Application Number 09/767,110 received on 03 September 2004..

Claims 1-12, 14-25, and 27 are presented for examination.

## **EXAMINER'S AMENDMENT**

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Jennifer Stewart (Registration Number 53639) on 12/08/2004.

Please cancel claims 4, 6, 16, and 18.

Please amend claims 1, 5, 15, 17, and 24 as follows:

1. (Currently Amended) A method of storing an e-mail address within an Abbreviated Dialing Number (ADN) record of a Subscriber Identity Module (SIM) card, the ADN record including a plurality of fields having personal contact information relating to a contact stored in the ADN record, said method comprising the steps of:

allocating a first number of bytes of memory space to a first field in the ADN record;

storing an e-mail address of a contact in the first field in the ADN record;

Art Unit: 2143

setting a flag in a second field in the ADN record indicating a presence of an e-mail address in the first field in the ADN record[.]; [and]

allocating a third byte <u>from said first number of bytes</u> in the first field in the ADN record for identifying a length of the e-mail address stored in the first field[.];

wherein the second field in the ADN record comprises a Type of Number/Numbering Plan Identification (TON/NPI) field; and

wherein an NPI portion of the TON/NPI field includes four binary bits, and
wherein the step of setting a flag in the second field in the ADN record indicating the
presence of an e-mail address in the first field in the ADN record comprises the step of
setting the NPI portion of the TON/NPI field equal to binary "1110".

- 2. (Original) The method of claim 1, wherein the first number of bytes allocated to the first field in the ADN record is equal to or less than 241 bytes.
- 3. (Original) The method of claim 1, wherein the first field in the ADN record comprises an Alpha Identifier field.
- 4. (Canceled)
- 5. (Currently Amended) The method of claim [4] 1, wherein the flag indicating the presence of an e-mail address is the first field in the ADN record is set in an NPI portion of the TON/NPI field.

Art Unit: 2143

Page 4

6. (Canceled)

7. (Original) The method of claim 1, wherein the ADN record includes a third field for

storing a dialing number associated with the contact, and wherein the method further

comprises the step of coding the third field in the ADN record as unused.

8. (Original) The method of claim 1, wherein the ADN record includes a third field for

storing a dialing number associated with the contact, and wherein the method further

comprises the step of storing an invalid phone number in the third field in the ADN

record.

9. (Previously Amended) The method of claim 1, wherein the method further comprises

the step of allocating a first byte in the first field in the ADN record for identifying a

second ADN record containing a phone number for the contact.

10. (Previously Amended) The method of claim 9, wherein the second ADN record

further includes an alphanumeric tag associated with the contact.

11. (Original) The method of claim 1, wherein the method further comprises the step of

allocating a second byte in the first field in the ADN record for identifying an extension

record containing a remaining portion of the e-mail address if the first number of bytes

Art Unit: 2143

Page 5

of memory space allocated to the first field in the ADN record is insufficient to store the e-mail address.

12. (Original) The method of claim 11, wherein the ADN record includes a fourth field for storing an extension record identifier, wherein the extension record identifier in the fourth field and the second byte in the first field each identify the extension record containing the remaining portion of the e-mail address if the first number of bytes of memory space allocated to the first field in the ADN record is insufficient to store the e-mail address.

# 13. (Canceled)

- 14. (Previously Amended) The method of claim 1, wherein the method further comprises the step of additionally storing an alphanumeric tag associated with the contact in the first field in the ADN record.
- 15. (Currently Amended) A method of storing an e-mail address within an Abbreviated Dialing Number (ADN) record of a Subscriber Identity Module (SIM) card, the ADN record storing subscriber-specific contact information relating to subscriber contacts and including a Dialing Number field having a first number of bytes of memory space for typically storing a phone number associated with a subscriber contact and an Alpha Identifier field having a second number of bytes of memory space for typically storing a

subscriber-defined alphanumeric tag associated with the subscriber contact, said method comprising the steps of:

storing an e-mail address in the Alpha Identifier field of the ADN record associated with a particular subscriber contact;

setting a flag in the ADN record indicating a presence of an e-mail address in the Alpha Identifier field; [and]

allocating a third byte <u>from said first number of bytes</u> in the Alpha Identifier field in the ADN record for identifying a length of the e-mail address stored in the Alpha Identifier field[.];

wherein the ADN record further includes a Type of Number/Numbering Plan

Identification (TON/NPI) field, and wherein the flag setting step comprises setting a flag
in the TON/NPI field indicating a presence of an e-mail address in the Alpha Identifier

field; and

wherein an NPI portion of the TON/NPI field includes four binary bits, and wherein the step of setting a flag in the TON/NPI field indicating the presence of an e-mail address in the Alpha Identifier field comprises setting the NPI portion of the TON/NPI field equal to binary "1110".

16. (Canceled)

Art Unit: 2143

17. (Currently Amended) The method of claim [16] <u>15</u>, wherein the flag set in the TON/NPI field indicating the presence of an e-mail address in the Alpha Identifier field is

Page 7

set in the NPI portion of the TON/NPI field.

18. (Canceled)

Number field as unused.

19. (Original) The method of claim 15, wherein the second number of bytes of memory space in the Alpha Identifier field is equal to or less than 241 bytes.

20. (Original) The method of claim 15, further comprising the step of coding the Dialing

21. (Original) The method of claim 15, further comprising the step of storing an invalid phone number in the Dialing Number field.

- 22. (Previously Amended) The method of claim 15, further comprising the step of allocating a first byte in the Alpha Identifier field for identifying a second ADN record including a phone number for the particular subscriber contact.
- 23. (Previously Amended) The method of claim 22, wherein the second ADN network further includes a subscriber-defined alphanumeric tag associated with the particular subscriber contact.

Art Unit: 2143

Page 8

24. (Currently Amended) The method of claim 15, further comprising the step of allocating a second byte in the Alpha Identifier field for identifying an extension record containing a remaining portion of the e-mail address if the second number of bytes of memory space allocated to the [Alpah] <u>Alpha</u> Identifier field in the ADN record is insufficient to store the e-mail address.

25. (Original) The method of claim 24, wherein the ADN record includes an Extension Record field for storing an extension record identifier, wherein the extension record identifier in the Extension Record field and the allocated second byte in the Alpha Identifier field each identify the extension record containing the remaining portion of the e-mail address if the second number of bytes of memory space allocated to the Alpha Identifier field in the ADN record is insufficient to store the e-mail address.

26. (Canceled)

27. (Previously Amended) The method of claim 15, further comprising the step of additionally storing a subscriber-defined alphanumeric tag associated with the particular subscriber contact in the Alpha Identifier field in the ADN record.

## **REASONS FOR ALLOWANCE**

Claims 1-3, 5, 7-12, 14, 15, 17, 19-25, and 27 are allowed.

Art Unit: 2143

Page 9

The following is an examiner's statement of reasons for allowance: The limitation including wherein an NPI portion of the TON/NPI field includes four binary bits, and wherein the step of setting a flag in the second field in the ADN record indicting the presence of an e-mail address in the first field in the ADN record comprises the step of setting the NPI portion of the TON/NPI field equal to binary "1110" (see enabling portions in the present specification, see Page 3, last paragraph, Page 4, lines 1-6, Page 15, lines 1-9) was not taught or suggested by the cited prior art of record in combination with the other limitations of all of the independent claims. The cited prior art of reference teaches a subscriber identifier being conceived as subscriber identifiers for electronic mail addresses but does not teach setting a flag in a field separate from the field containing the email address, where setting a flag includes setting the NPI portion of a TON/NPI field equal to binary "1110".

The dependent claims further limit the independent claims and are considered allowable on the same basis as the independent claims as well as for the further limitations set forth.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

## Drawings

Examiner requests that Applicant submit formal drawings to the drafts person.

#### Conclusion

Art Unit: 2143

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Bret Dennison whose telephone number is (571)272-3910. The examiner can normally be reached on M-F 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (571)272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

J. Bret Dennison Patent Examiner Art Unit 2143

imary Examiner